

## **REMARKS**

This Reply is filed in response to the November 24, 2010 Office Action.<sup>1</sup> Claims 1-19 and 21 were presented for examination and were rejected. The claims are not amended. No claims are added or canceled. Claims 1, 7, 13, 18 and 21 are in independent form. Claims 1-19 and 21 are pending.

Claims 1-19 and 21 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 1-19 and 21 are rejected under 35 U.S.C. §103(a) as allegedly being un-patentable over U.S. Patent No. 7,046,779 B2 to Hesse (hereinafter "Hesse") in view of U.S. 2004/0093290 to Doss et al. (hereinafter "Doss"). Applicants respectfully traverse.

### **35 U.S.C. §112 Rejection**

Claims 1-17 are rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Per the Office Action, the independent claims recite the limitation "*visitation in person with said inmate at a correctional facility in which said inmate is housed*" (emphasis added) and, per the Office Action, the Examiner cannot find subject matter described by this limitation in Applicants' originally filed specification. (Office Action pgs 3-4) But, this subject matter does appear in the originally filed application. As presented in Applicants' previous response, *see* at least paragraphs [0001], [0002], [0006], [0008], [0016], [0030], [0034], [0057], [0062] and [0066] of Applicants' specification.

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<sup>1</sup> The Office Action may contain a number of statements characterizing the cited references and/or the claims which Applicants may not expressly identify herein. Regardless of whether or not any such statement is identified herein, Applicants do not automatically subscribe to, or acquiesce in, any such statement.

Paragraph [0001] says, among other things, that an exemplary embodiment of the present invention relates to a system used for “*inmates housed in a department of corrections facility.*” Paragraph [0002] says, among other things, that “*visits are permitted to be made each day to inmates of correctional facilities.*” Paragraph [0006] presents a system comprising, among other things, “a visitation scheduling module for scheduling, for approved visitors, an available time to visit an inmate.” Paragraph [0008] says, among other things, an exemplary embodiment “relates to registration, approval and scheduling of *inmate visitors at*, for example, *a department of corrections facility.*” Paragraph [0016] says, among other things, that “the exemplary embodiments will be described in relation to *inmates at a department of corrections facility.*” Paragraph [0030] says, among other things, that a bar code, or the like, can “facilitate check-in *upon the visitor(s) arriving at the prison.*” Paragraph [0034] says, among other things, that the visitor presents a confirmation number to a department of corrections official, “*when the visitor arrives at the prison.*” Paragraph [0057] says, among other things, that the *visitor* is issued a confirmation ticket which can include, for example, “directions and instructions on *what to do when arriving at the prison.*” Paragraph [0066] says, among other things, in reference to the flowchart of Fig. 11, that “*In step S1105 the visitors arrive [at the prison] and in step S1110 the visitors check-in.*” (italics added throughout)

Applicants submit that the examples given above, which describe visitors arriving at a prison to visit an inmate housed at the prison, are clear support for claim language reciting: “*visitation in person with said inmate at a correctional facility in which said inmate is housed.*” (emphasis added) The precise words of the claims need not appear in the specification: “While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure.” MPEP 2163(I)(B) Clearly, this

limitation is supported in the original specification through express, implicit or inherent disclosure as demonstrated by the above-noted paragraph references. Accordingly, it is respectfully submitted that the 35 U.S.C. §112 rejection of claims 1-19 and 21 is overcome and it is respectfully requested that the rejection be withdrawn.

**35 U.S.C. §103(a) Rejection**

**receiving a visitation request *only from inmate having visitation privileges***

Claim 1, for example, is rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Hesse in view of Doss. Claim 1 recites, *inter alia*: (a) “means for determining via a prison interface if the inmate has visitation privileges” and (b) “means for receiving a visitation request only from an inmate having said visitation privileges...” These two claim limitations (using parenthetical “a” and “b” designations herein only for ease of reference in this discussion) are considered together.

The (a) limitation relates to determining if an inmate has visitation privileges and the (b) limitation relates to receiving a visitation request, but only from an inmate having those privileges. In other words, if that inmate is determined to *not* have the visitation privileges recited in (a) then a visitation request is *not* received in (b) as it otherwise would have been. If a visitation request is not received in (b), then operation of all subsequent claim elements is concomitantly inhibited. (This is expressly recited in claim 21.) Subsequent elements of claim 1, with added convenience identifiers (c) through (g) are:

(c) means for sending a registration request to each of the plurality of potential visitors based upon the received visitation request;

(d) means for receiving registration information from said each of said plurality of potential visitors based upon the sent registration request;

(e) means, responsive to operation of said registration information receiving means, for determining whether the visitation request from the privileged inmate is approved or disapproved;

(f) means for communicating the approval or disapproval of the visitation request; and

(g) means, operative in response to said registration receiving means, for permitting one of said plurality of said potential visitors to schedule said same visitation for all of said plurality of potential visitors if said visitation request is approved.

If a visitation request is *not* received in (b) because the inmate does not have visitation privileges then in the (c) limitation above the “means for sending a registration request” does *not* send that request because it is based upon a “received visitation request” which it does *not* receive because it does not exist when the inmate does not have visitation privileges.

Because a visitation request is *not* received in (b) then in the (d) limitation above the “means for receiving registration information” does *not* receive registration information because it is based on a “sent registration request” in (c) which is *not* sent because it does not exist when the inmate does not have visitation privileges.

Because a visitation request is *not* received in (b) then in the (e) limitation above the “means, responsive to operation of said registration information receiving means, for determining...” does *not* determine approval or disapproval of the visitation request because the registration information receiving means in (d) does not receive registration information because it does not exist when the inmate does not have visitation privileges.

Because a visitation request is *not* received in (b) then, similarly, in the (f) limitation above the “means for communicating” does not communicate approval or disapproval of the visitation request and in the (g) limitation above the “means for permitting” the scheduling of the visit is not permitted, when the inmate does not have visitation privileges.

Clearly, operation of claim 1 is predicated upon an inmate having visitation privileges and without those privileges each subsequent claim limitation does not operate to provide a result. (As noted, this is expressly recited in claim 21.) But, Hesse does not shut down in this respect. Hesse, col. 7, lines 30-42, is cited against various of the limitations above and it says:

A schedule conference process 204 creates, revises, and deletes records stored in a database of conference plans 208 to establish a conference to be held at a date and time in the future. Conference plans may be maintained as a record of conferences completed (successfully through expected duration, or otherwise unsuccessfully) or cancelled. Rules referred to by process 204 from store 206 may *limit participation in conference plans to described participants generally or to qualified participants (e.g., having particular attributes, prior registration, or approval)*. Qualification may be established by any conventional work flow or work group software. Process 204 provides a conventional user interface for use by administrators 114. (Hesse, col. 7, lines 30-42; emphasis added)

In reference to the above passage, the Examiner states “limit participation to qualified participants” and he associates that with Applicants’ inmate having visitation privileges. (Office Action pgs 4-5) In fact, this Hesse passage *does* refer to limiting participation in conference plans to qualified participants, such as those having approval, as italicized in the passage above. At first blush, this may appear relevant to Applicants’ recited “inmate having said visitation privileges” but, upon examination, it is not relevant for the following reasons.

In Hesse, as gleaned from the above-quoted passage, if a potential participant is not qualified, quite simply that unqualified potential participant, alone, does not participate in the Hesse visitation, BUT THE HESSE VISITATION GOES FORWARD WITHOUT THAT UNQUALIFIED PARTICIPANT. Quite oppositely, if Applicants’ recited inmate does not have visitation privileges as per the (a) limitation of claim 1, then each of the remaining limitations of claim 1 do not produce any result because a meeting does not take place. Hesse cannot be read upon these limitations because Hesse *always* produces a result in the sense that its meeting is not canceled because of an unqualified participant.

For example, with respect to Applicants' limitation (c) "means for sending a registration request to each of the plurality of potential visitors based upon the received visitation request" the registration request is not sent to Applicants' recited visitors if the inmate does not have visitation privileges. But, by contrast, in Hesse, even if a visitor is disqualified, any alleged equivalent of Applicants' "registration request" in Hesse is *still* sent to all remaining potential visitors. The sections in Hesse applied in the Office Action against this claim limitation do not shut down simply because a Hesse participant does not qualify. The Hesse meeting goes forward. Hesse is not prevented from pursuing its video conference meeting; it merely dis-invites only the unqualified participant. Doss, cited merely for curing an admitted "in person" disclosure deficiency in Hesse does not cure this instant deficiency in Hesse.

The Office Action attempts to read the above-quoted section and others in Hesse against virtually all of the limitations of claim 1. But, Hesse is irrelevant or ineffective for reasons given above and Doss doesn't cure. Therefore, Applicants submit that Hesse and Doss taken individually or in any reasonable combination do not disclose or suggest the subject matter of claim 1. Therefore, for reasons given above, Applicants respectfully request that the 35 U.S.C § 103(a) rejection of claim 1 be withdrawn and the claim allowed.

**permitting one of the potential visitors to schedule the visitation**

Claim 1, rejected under 35 U.S.C. §103(a) as allegedly being un-patentable over Hesse in view of Doss, is allowable over these references for another reason, even if the inmate has visitation privileges. Claim 1 recites, *inter alia*: (g) "means, operative in response to said registration receiving means, for *permitting one of said plurality of said potential visitors to schedule said same visitation for all of said plurality of potential visitors* if said visitation

request is approved.” (emphasis added) The Examiner applies the Hesse, Fig. 10 flowchart against this claim limitation. (Office Action, pg 5) But, this flowchart does not disclose or suggest this claim limitation because Hesse’s *visitors* do not schedule the visitation.

Hesse says: “Fig. 10 is a process flow diagram of a method for scheduling a conference according to various aspects of the present invention.” (Hesse, col. 3, lines 6-8) But, even according to *all* aspects of Hesse’s present invention, it is clear that the Hesse method for scheduling a conference relies solely upon its administrator and not upon one of its potential visitors. For example: “A conference is scheduled by an administrator who operates the conference control station.” (Hesse, col. 1, lines 51-53) “Administrators schedule conferences as requested by human participants.” (Hesse, col. 4, lines 7-8) “A schedule conference process 204 creates, revises, and deletes records stored in a database of conference plans 208 to establish a conference to be held at a date and time in the future. . . . . Process 204 provides a conventional user interface *for use by administrators 114.*” (Hesse, col 7, lines 30-33 and lines 41-42; emphasis added)

Clearly, Hesse’s administrator is the person who schedules the conference but Hesse’s administrator is not a visitor and is thus not equivalent to “one of said plurality of said potential *visitors*” as recited in claim 1. (emphasis added) Doss was cited for teaching “in-person” meetings, but its invitees, with their calendars interconnected via a network, inherently provide input to each other to *collectively* pre-agree to a meeting time/place/character that satisfies *all* of the conditions of *all* of the invitees. For example, see Doss paragraph [0105] where specific input to the database is provided by an invitee for a specific reason. Therefore, in Doss, although *one* person may initiate a *search* for available time from each invitee (Doss, at least paragraph [0094]), the input to the database is from all invitees. Therefore, *all* invitees *schedule* the

meeting at a mutually-acceptable time and under mutually acceptable conditions, via pre-agreement responsive to a search of available time, location, conditions, etc. in the database.

The meeting is scheduled, and/or agreed to, as a result of *all* invitees operating in concert, not as a result of one invitee scheduling the meeting. Thus, any alleged combination of Hesse and Doss does not disclose or suggest “means, operative in response to said registration receiving means, for permitting *one* of said plurality of said potential visitors to *schedule* said same visitation for all of said plurality of potential visitors if said visitation request is approved” as recited in claim 1. (emphasis added) Moreover, because Doss is not combinable with Hesse for reasons given below, it cannot cure this deficiency in Hesse, regardless of interpretation of the role of the singular user/searcher in Doss doing the initial searching.

Therefore Hesse and Doss taken individually, or in any reasonable combination, do not disclose or suggest: “means, operative in response to said registration receiving means, for permitting one of said plurality of said potential visitors to schedule said same visitation for all of said plurality of potential visitors if said visitation request is approved” as recited in claim 1. Accordingly, for these *additional* reasons, the 35 U.S.C. §103(a) rejection of claim 1 should be withdrawn and the claim allowed.

**Hesse is not combinable with Doss**

The Office Action, page 6, alleges that combining Hesse and Doss would make Applicants’ recited subject matter obvious because “the claimed invention is merely a combination of old elements.” Without acquiescing in/to the Office Action, whether or not Applicants’ recited subject matter is a combination of old elements, by itself, would not



determine patentability. A combination of old elements providing new, useful and non-obvious subject matter, as claimed in this instance, is patentable.

The Office Action, page 6, further alleges that one of ordinary skill in the art would have recognized that this combination would produce a predictable result of using the [Hesse] system to indicate whether or not the meeting is in person. But, with a system that does not contemplate in-person meetings at all, as in Hesse, because it operates fundamentally differently from operation of Doss which does contemplate in-person meetings, there is *no* predictable result from that alleged combination because it simply cannot be made in the first place, as discussed below.

The Office Action, page 6, further alleges that the systems would behave in the same way whether the meeting was in person or in the same facility or with a teleconference, and this is plainly inaccurate as discussed below.

Hesse relates solely to arranging for video conferencing meetings and nothing more. (Title and Abstract) Doss relates to searching electronic calendars to find available time that is common to all potential participants during which a meeting can be scheduled, and to find other relevant information about each potential participant, so that an in-person, video, e-mail, or telephonic meeting can be arranged. (Abstract; paragraphs [0003] and [0080]-[0088]) Hesse cannot be combined with Doss for various reasons.

First of all, Hesse has absolutely nothing to do with in-person or face-to-face meetings. The entire thrust of Hesse is to schedule video conferencing, and *only* video conferencing. This is the acknowledged deficiency in Hesse when it is applied against Applicants' claims in the Office Action. Thus, to attempt to combine *any* reference that discloses arranging for in-person meetings, which is one aspect of Doss, with Hesse doesn't pass a common-sense test because there is no reason expressed or implied in Hesse for *ever* considering it from, or in connection

with, a viewpoint of in-person meetings. In Applicants' view, respectfully, it is implausible to consider Hesse in combination with the *in-person* aspects of Doss. Even if Doss could be combined with Hesse because video conferencing is disclosed in both Hesse and Doss, *the in-person meeting aspect of Doss would still not mesh with Hesse* and that aspect of Doss would still remain uncombinable with Hesse. In other words, the *sole* expression of video conferencing in Hesse *repels* its combination with *any* disclosures of in person meetings.

Although communication may be achieved in both an in-person meeting and in a video-conference meeting, that commonality of purpose and result doesn't convert a publication dedicated *only* to video-conferencing into a publication conducive to a context of in person meetings. The two activities, (1) *only* video conferencing and (2) in-person meetings, are physically very different and, without fundamental design changes, physically incompatible. Doss has both, but only because it was designed for both from the outset; however, Hesse is designed only for video conferencing and remains incompatible in alleged combination with Doss, as explained below.

Indeed, the principle of operation of Hesse would have to be changed for the Hesse/Doss combination to be operative, and that is a forbidden result. "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)." M.P.E.P. § 2143.01. Moreover, "[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." M.P.E.P. § 2143.01.

Hesse and Doss operate differently. Hesse discloses non-participant personnel, those who are not in attendance at a meeting, such as administrators, to set up the meeting via a schedule conference process 204. (*see* Hesse, Fig. 2) “A conference is scheduled by an administrator who operates the conference control station.” (Hesse, col. 1, lines 51-53) “Administrators schedule conferences as requested by human participants.” (Hesse, col. 4, lines 7-8) “A schedule conference process 204 creates, revises, and deletes records stored in a database of conference plans 208 to establish a conference to be held at a date and time in the future.....Process 204 provides a conventional user interface *for use by administrators* 114.” (Hesse, col 7, lines 30-33 and lines 41-42; emphasis added) The administrator has access to the database of information about all potential participants.

But in Doss, it is the participants themselves who have access to each others’ electronic calendars and any of them can perform a *search* for mutually-agreeable time/location/conditions pre-agreed by all meeting invitees. (Doss, at least paragraph [0094]) In fact, in Doss, the invitees must have access to each others’ calendars for Doss to operate. There is no easily discernable way that Doss’s operation can be made compatible with Hesse’s operation. A database accessible only by a non-participant (non-invitee) as in Hesse is not compatible with a different database accessible only by participants (invitees) as in Doss, and the principle of operation of Hesse must be changed in order to combine these two references, thereby making Hesse inoperative for the purpose for which it is designed. This is an *additional* reason why the two references cannot be combined.

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Independent claims 7, 13, 18 and 21 each recites limitations that are the same as, or similar to those of claim 1 presented above. Claims 7, 13, 18 and 21 are, therefore, allowable for reasons which are the same as, or similar to, those given above for allowability of claim 1.

Dependent claims 2-6, dependent from claim 1 are also allowable, at least for reasons based on their respective dependencies from allowable base claim 1.

Dependent claims 8-12, dependent from claim 7 are also allowable, at least for reasons based on their respective dependencies from allowable base claim 7.

Dependent claims 14-17, dependent from claim 13 are also allowable, at least for reasons based on their respective dependencies from allowable base claim 13.

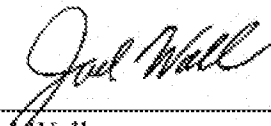
Dependent claim 19, dependent from claim 18 is also allowable, at least for reasons based on their respective dependencies from allowable base claim 18.

### **CONCLUSION**

Reconsideration and allowance are respectfully requested in view of the foregoing amendments and remarks.<sup>2</sup> Applicant submits that all objections and rejections have been addressed and have been overcome.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

Respectfully submitted,  
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Date: **January 24, 2011**

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<sup>2</sup> As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, assertions as to dependent claims, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such assertions/requirements in the future.